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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,196	07/06/2000	Denise E. Smith	ATL99003	5114

25537 7590 10/08/2003

WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC 20036

EXAMINER

BARNIE, REXFORD N

ART UNIT	PAPER NUMBER
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2643

18

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory ActionApplication No.
09/611,196Applicant(s)
SMITH ET AL.Examiner
REXFORD BARNIEArt Unit
2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 26, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see NOTE below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
the explanation as set forth in the rejection of the claimed subject matter is believed proper and permissible.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: _____
- Claim(s) withdrawn from consideration: _____
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

R. Barnie
REXFORD BARNIE
PRIMARY EXAMINER

10/04/03
Part of Paper No. 18

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Response to Arguments

1. Applicant's arguments filed on 08/26/2003 have been fully considered but they are not persuasive. .

The applicant in response to the final rejection dated 07/01/2003 basically argued the following arguments.

(I) The applicant argued on (page 2 lines 13-15, page 4) that the combination including Holstrom and Taskett fails to teach a multi-purpose calling card *approximately* the size of a conventionally calling card.

The examiner disagrees because the combination as set forth in the rejection of the claimed subject matter does not put a restriction on the size of the calling card such as taught by Holstrom. Furthermore, according to Holstrom in (see col.2 lines 49-51) the card can have a scope similar to that of a standard credit card and also, all calling cards do not have the same size. Another feature is that the limitation calls for "approximately" which would be rendered obvious by the combination based on the explanation given above.

(II) The applicant argued on (page 2 lines 16-21) that the combination fails to teach a multi-purpose calling card with a tag portion and a key portion.

The examiner disagrees because the combination including Holstrom teaches a calling card or a card with which one can make a telephonic connection based on an identifier unique or

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associated with the card over a network comprising of two portions including a tag portion and a key ring portion (see abstract, figs. 1-3). Thus, the explanation as set forth regarding the limitations believed to be proper and permissible.

(III) The applicant argued that in (see page 5 lines 20-page 6) that the combination fails to teach receiving personal identification and encoding each multi-purpose card including a main portion and a key tag portion with the information on at least one of the portion namely; main or key tag portion.

The examiner believes the explanation as set forth in the rejection of this limitation is believed proper and permissible and see the explanation as set forth in the rejection regarding claim 7. The examiner disagrees because personal information is broad and thus can be read on a unique identifier such as a PIN on an article. The combination including Holstrom teaches in (see fig. 1), a unique or if not unique an identifier associated with a card with which one can make a telephone connection to a remote station.

In response to the applicant's argument in specifically (see page 6 lines 11-14) that Holstrom doesn't give a user the flexibility to customize the card,

The examiner re-iterated in the final office action that the fact that the personal information can be information customized by a user/purchaser is not directed to the claimed subject matter.

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(IV) The applicant argued that the combination fails to render obvious the subject matter of separating a main portion from a key portions by means of five perforations.

The examiner disagrees because the combination teaches the possibility of being able to use perforations in separating one portion of a card from the other but doesn't specifically limit or mention the number of perforations required to do so. Thus, the examiner in rejecting the claimed limitation believes the combination would render the limitation obvious in part based on design choice in addition to the fact that there is no restriction on the number of perforation set forth by the combination.

(V) The applicant argued in (see pages 11-13) that the prior art of record fails to teach being able to customize a card with personal information by a user wherein the information is placed on the key ring portion of the card.

The examiner disagrees because in rejecting the claimed subject matter, the examiner tried to show that being able to customize a card to include any desired information including personal expressions like greetings and so forth is well known such as taught by Small. In response to the applicant's argument that the fact that card is to be customized by a user or purchaser is not directed to the claim but implying that the card could include personal expressions as one of the options which according to the applicant's disclosure could be a picture of family, messages such as congratulations and so forth could mean that a user or purchaser could place any desired personal information on the card as a gift such as taught by Small.

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Placing company logos or advertising information on a card is also notoriously well known.

It would have been obvious to one of ordinary skill in the art that desired information can be placed anywhere on the card as desired by a user or purchaser wherein the personal expressions could including messages or greetings such as taught by Small given the fact *that the combination including Holstrom teaches personal information (Identifier) on both portions of the card as a possibility.*

(VI) The applicant argued in (page 15) that the motivation for the combination including Small is based on hindsight and lacks motivation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, Small teaches being able to customize cards including calling cards for gift purposes with any desired information thus rendering obvious the fact that a calling card can be customize by a user with any desired information.

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(VII) The applicant argued that the combination including MacWilliams fails to render claim 30 obvious.

The explanation as set forth in the rejection of the claimed subject matter is believed proper and permissible because placing a label over perforations is known as taught by MacWilliams.

(VIII) In summary, the explanation in the rejection as set forth regarding the claimed subject matter is believed proper and permissible.

Conclusion

2. Any inquiry concerning this communication or earlier communication from the examiner should be directed to REXFORD BARNIE whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to (703) 872-9314 and labeled accordingly (Please label

"PROPOSED/INFORMAL" or "FORMAL").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 306-0377.

Rexford Barnie
Patent Examiner
RB 10/04/03.

R. Barnie
REXFORD BARNIE
PRIMARY EXAMINER